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10/027,704	12/21/2001	George H. Forman	10013643-1	4185

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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,704	FORMAN, GEORGE H.	
	Examiner J. Bret Dennison	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 May 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3 and 22-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3 and 22-32 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____



DETAILED ACTION

1. This Action is in response to Application Number 10/027704 received on 27 May 2005.
2. Claims 1-3 and 22-32 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 1 recites the limitation, "and/or", making the claim indefinite. It is unclear to Examiner what is actually being indicated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-3 and 22-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Friskel (U.S. Patent Number 6,839,737).

5. Regarding claim 1, Friskel disclosed a method for use at a server that is accessible by a plurality of email sending applications, said method comprising:

maintaining a table of statuses for a plurality of email addresses, wherein the table is searchable by email address, and wherein the status for each email address indicates current email message receiving and/or handling capability at said email address (Friskel, col. 3, lines 20-25);

receiving an inquiry from a sender application regarding the status of a specified email address (Friskel, col. 6, lines 33-35); and

in response to the inquiry, searching the table for and then transmitting the status for the specified email address (Friskel, col. 6, lines 40-48).

6. Regarding claim 2, Friskel disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the status for the specified email address indicates if (1) the email address of the recipient email address is not valid or no longer valid, (2) the recipient email address is set in an auto-reply mode, or (3) the auto-reply mode for the recipient email address is not set (Friskel, col. 7, lines 25-30).

7. Regarding claim 3, Friskel disclosed the limitations, substantially as claimed, as described in claim 1, including the steps of:

receiving updates to the statuses of the recipient email addresses on an ongoing basis (Friskel, col. 6, lines 5-10); and

recording the updates in the table (Friskel, col. 6, lines 10-12).

8. Regarding claim 22, Friskel disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the table is located in an email server (see Abstract, Friskel provides a messaging system server that manages and provides email status).

9. Regarding claim 23, Friskel disclosed a method of alerting a user prior to the user sending an e-mail message, said method comprising:

obtaining an indication that a user wishes to send an e-mail message to a designated e-mail address (Friskel, Fig 7, 700, col. 6, lines 30-35);
in response to said indication, transmitting a request regarding a current availability of a recipient that is associated with the designated e-mail address (Friskel, col. 6, lines 5-10);

receiving a reply that indicates the availability of the recipient at the designated e-mail address (Friskel, col. 6, lines 34-36); and

alerting the user, prior to the user sending the e-mail message, if the reply indicates that the recipient is not currently available at the designated e-mail address (Friskel, col. 45-47, Fig. 7, 710 and 712, Figure 7 of Friskel shows the user being alerted of the email address status before sending an standard email message).

10. Regarding claim 24, Friskel disclosed the limitations, substantially as claimed, as described in claim 23, including wherein the indication that the user wishes to send the

e-mail message comprises entry of the designated e-mail address as an intended recipient of the e-mail message (Friskel, Fig. 7, 700).

11. Regarding claim 25, Friskel disclosed the limitations, substantially as claimed, as described in claim 24, including wherein the request is transmitted as soon as the designated e-mail address, as entered, has been resolved (Friskel, Fig. 7, 706 and 708).

12. Regarding claim 26, Friskel disclosed the limitations, substantially as claimed, as described in claim 24, including wherein the request is transmitted automatically in response to entry of the designated e-mail address as an intended recipient of the e-mail message (Friskel, Fig. 7, 700, 702).

13. Regarding claim 26, Friskel disclosed the limitations, substantially as claimed, as described in claim 24, including wherein the user is alerted that the recipient is not currently available at the designated e-mail address while the user still is composing the e-mail message (Friskel, col. 6, lines 45-47).

14. Regarding claim 28, Friskel disclosed the limitations, substantially as claimed, as described in claim 23, including wherein the user is visually alerted that the recipient is not currently available at the designated e-mail address (Friskel, col. 6, lines 45-47).

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15. Regarding claim 29, Friskel disclosed the limitations, substantially as claimed, as described in claim 23, including wherein the request is transmitted to a server that is known to maintain a database of current availability statuses for different e-mail addresses (Friskel, col. 6, lines 34-35).

16. Regarding claim 30, Friskel disclosed the limitations, substantially as claimed, as described in claim 23, including wherein the reply indicates if (1) the email address of the recipient e-mail address is not valid or no longer valid, (2) the recipient e-mail address is set in an auto-reply mode, or (3) the auto-reply mode for the recipient e-mail address is not set (Friskel, col. 7, lines 25-30).

17. Regarding claim 31 and 32, Friskel disclosed an apparatus for alerting a user, prior to the user sending an e-mail message, that the intended recipient is not currently available at a user-designated e-mail address, said apparatus comprising:

a processor for executing stored program instruction steps (Friskel, col. 3, lines 14-20); and

a memory connected to the processor for storing the program instruction steps (Friskel, col. 4, lines 50-60),

wherein the program instruction steps include steps of:

obtaining an indication that a user wishes to send an e-mail message to a designated e-mail address (Friskel, Fig 7, 700, col. 6, lines 30-35);

in response to said indication, transmitting a request regarding a current availability of a recipient that is associated with the designated e-mail address (Friskel, col. 6, lines 5-10);

receiving a reply that indicates the availability of the recipient at the designated e-mail address (Friskel, col. 6, lines 34-36); and alerting the user, prior to the user sending the e-mail message, if the reply indicates that the recipient is not currently available at the designated e-mail address (Friskel, col. 45-47, Fig. 7, 710 and 712, Figure 7 of Friskel shows the user being alerted of the email address status before sending an standard email message).

Response to Amendment

Applicant's arguments and amendments filed on 27 May 2005 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations into the independent claims, and also including new claims which will require further consideration*) to the claims which significantly affected the scope thereof.

Applicant's arguments with respect to claims 1-3 and 22-32 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of "maintaining a table of statuses for a plurality of email addresses, where the status for each email address indicates current email message receiving and handling capability at such email address [see Applicant's Response, page 8, first paragraph]. It is evident from the

mappings found in the above rejection that Friskel disclosed the teaching of a server that maintains a contacts file that contains a list of email addresses and their and their on-line status information (Friskel, col. 3, lines 12-14, 20-25, 30-33).

Applicant's also argues "Friskel primarily is directed to techniques for facilitating two-way non-email communication upon receipt of an e-mail message" [see Applicant's Response, page 9, first paragraph]. However, as cited in the above rejection, Friskel gives the user an option to either send an email or chat in real time (Friskel, Fig. 7, 710 and 712). Therefore, Friskel disclosed checking the status of a user, and based on that status, sending an email message, as disclosed in the claimed invention.

Applicant's also argues that "the status information presented to an e-mail recipient in Friskel is qualitatively different than the status information of the present invention" [see Applicant's Response, page 9, second paragraph]. The status as currently disclosed "indicates current email message receiving and/or handling capability". The on-line status of the user of an email address, as disclosed in Friskel, indicates that the user is capable of receiving an email at that instant.

As shown in the above rejection, Friskel disclosed a user requesting status of a specific email address from a server, the server keeping an updated list of email addresses and their statuses, the server responding to the user with the updated status of the specific email address, and the user being alerted of the status with a displayed message. By Friskel showing these limitations, Friskel clearly taught the independent claims of Applicant's claimed invention.

Applicant's arguments with respect to claims 1-3 and 22-32 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims, which significantly affected the scope thereof.

Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Friskel as well as other prior arts of records disclosed, maintaining and providing the status of email addresses is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

It is presumed that claim 32 invokes "means plus function" language and interpretation in accordance with 35 USC 112 sixth paragraph. In order to verify and ascertain the metes and bounds of the claimed invention, Applicant is requested to isolate the portion(s) of the specification which dictates the structure relied on for proper interpretation if this presumption is appropriate.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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